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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,424	02/11/2000	Andrzej Kilian	191106.407C1	5142

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EXAMINER

WALICKA, MALGORZATA A

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/502,424

Applicant(s)

KILIAN ET AL.

Examiner

Malgorzata A. Walicka

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: 65.

Claim(s) rejected: 1,4-6,11-15,27-29,31,32,34,61,65,67,71-85,92,93 and 101.

Claim(s) withdrawn from consideration: _____.

8. ☒ The proposed drawing correction filed on 06 October 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: all rejections except as noted above are maintained for the reasons of record in view of the non-entry of the amendment .

The amendment filed October 6, 2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance. Amendment to the Specification, Drawings and Sequence Listing have been entered.

The amendments to the claims have not been entered because they raise new issue, which would require further search and consideration.

Advisory Action

1. Objections

1.1. Specification

The objection to the specification for lack of compliance with sequence rules made in the final rejection is withdrawn, because the corrections filed after final rejection have been entered.

The objection to Table 1 made in the final rejection is withdrawn, because the Applicants arguments filed after final are found persuasive.

Specification is still objected to because in the Sequence listing SEQ ID NO: 35 and 52 are described as N-terminal truncated telomerase, whereas the sequences are not N-terminal-truncated but C-terminal-truncated. The proteins are identical to residues 1- 588 and 1-622 of the reference protein of SEQ ID NO: 2, which consists of 1132 amino acids. Thus both proteins lack C-terminus of the reference protein. The N-terminal amino acid of SEQ ID NO: 2 is residue number 1, and the C-terminal amino acid is residue number 1132. Description of Fig. 11A and L are also confusing, because they repeat the description "N-truncated".

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1.3. Sequence listing

SEQ ID NOs: 35 and 52 are C-terminal truncated variant of human telomerase reverse transcriptase. An amended paper and CRF copies of the sequence listing are requested, as well as statement of sameness thereof. It is suggested that the description be changed from "N-terminal truncated telomerase" to "truncated telomerase".

1.4. Claims

The objection to claim 65 under 37 CFR 1.75 made in the final rejection are not withdrawn, because the amendments to the claims filed after the final rejection have not been entered.

2. Rejections

2.1. 35 USC 112, second paragraph

Claim 1, 4, 11-15, 65-67, 73-79 and 101 remain rejected under 35 U.S.C. 112, second paragraph for the reasons indicated in the final rejection.

2.2. 35 U.S.C. 112, first paragraph

2.2.1. Lack of written description

Claims 1, 4, 5-6, 11-15, 27, 61, 65-67, 73-79, 80-85, and 101 are rejected under 35 USC section 112 first paragraph for reasons indicated in the final rejection.

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2.2.2. Scope of enablement

Claims 1, 61, 65, 67, 73-79, 80-85 and 101 remain rejected under 35 U.S.C. 112, first paragraph, for reasons stated in the final rejection.

2.4. 35 USC section 102

Claims 1, 4, 6, 11-15, 27-29, 31, 32, 34, 61, 80-85 and 92 are rejected under 35 USC 102(e) for the reasons indicated in the final rejection.

2. 5. Double patenting

Obviousness type provisional double patenting is withdrawn, because application No. 9/108, 401 has been abandoned.

3. Remarks

To speed up the prosecution and place the case in condition for allowance the examiner presented by e-mail, on December 4, 5, and 8, 2003, proposals for examiner's amendment to the claims and specification. The proposals were provisionally accepted by the Applicants' representative Carol Nottenburg.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka, Ph.D., whose telephone number is (703) 305-7270. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m.

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If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D. can be reached on (703) 308-3804. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionists whose telephone number is (703) 308-0196.

Malgorzata A. Walicka, Ph.D.

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Patent Examiner



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